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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/822,124

03/30/2001

Ellen M. Nelson

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02/09/2005

AGILENT TECHNOLOGIES, INC.

Legal Department, 51U-PD

Intellectual Property Administration

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EXAMINER

CARDONE, JASON D

ART UNIT

PAPER NUMBER

2145

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/822,124		NELSON ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Jason D Cardone		2145	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/3/01</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The amendment filed 6/19/2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: formal drawings were filed with the addition of Figure 11. Figure 11 was not of the original disclosure. If the examiner discovers new matter in a substitute or additional drawing, the drawing should not be entered. The drawing should be objected to as containing new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. Claim 16 is objected to because of the following informality: it is suggested that claim 16 depend upon independent claim 10. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 7-10 and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject

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matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe the claimed subject matter, in claims 7-10, in such a way that one of ordinary skill in the art, at the time of the invention would be able to make or use the invention. Claims 7 and 17 disclose elapse time but not in connection to what times are elapsed. Claims 8, 9, 18 and 19 disclose a required string or a prohibited string in a server response but not what type strings or the functions of the strings or an example of the strings. The specification does not disclose how the strings relate as a test measurement. Claims 10 and 20 disclose recording pauses and redefining pauses. The specification discloses "pauses for the URL" but does not disclose what the pause is related to (ie. collecting links to the URL, displaying URL, obtaining URL web page?). The specification is silent on how to redefine a pause.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3-5, 11 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Marullo et al. ("Marullo"), USPN 6,044,398.

Regarding claim 1, Marullo discloses a software product for a computer system to configure a transaction for a user operating a web browser wherein the transaction is used for automated testing of an Internet server system, the software product comprising: test instructions configured direct a processor to interact with the web browser and the Internet server system to record web browser activity to generate the transaction [ie. webrunner, Marullo, col. 7, line 10 – col. 8, line 17],

edit the transaction [Marullo, col. 8, lines 4-17, col. 16, line 54 – col. 17, line 13 and col. 23, lines 5-24],

perform an automated test of the Internet server system using the transaction [Marullo, col. 8, lines 18-26 and col. 24, lines 10-27], display test results to the user from the automated test [Marullo, col. 14, lines 55-65 and col. 21, lines 34-67], and

save the transaction for subsequent automated testing of the Internet server system ; and a storage medium configured to store the test instructions [Marullo, col. 8, lines 4-40].

8. Regarding claim 3, Marullo further discloses the test instructions are further configured to direct the processor to record the web browser activity to generate test measurements [Marullo, col. 6, lines 24-49].

9. Regarding claim 4, Marullo further discloses one of the test measurements is a sequence of web pages [Marullo, col. 3, lines 1-35 and col. 7, lines 10-35].
10. Regarding claim 5, Marullo further discloses the test instructions are further configured to direct the processor to add test measurements to the transaction including transaction time and transaction data transfer rate [Marullo, col. 4, line 66 – col. 5, line 7].
11. Regarding claims 11 and 13-15, claims 11 and 13-15 have similar limitations as claims 1 and 3-5. Therefore, the similar limitations are disclosed under Marullo for the same reasons set forth in the rejection of claims 1 and 3-5 [Supra 1 and 3-5].

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 2, 6-10, 12 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marullo in view of Ramanathan et al. ("Ramanathan"), USPN 6,041,041.

15. Regarding claim 2, Marullo substantially discloses the claimed subject matter. Marullo does not specifically disclose the test instructions are further configured to direct the processor to interact with the web browser and the Internet server system through a firewall. However, Ramanathan, in the same field of endeavor, discloses test instructions through a firewall [Ramanathan, col. 6, line 34 – col. 7, line 20]. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate a firewall, taught by Ramanathan, into the testing system, taught by Marullo, in order to improve security and more realistic testing.

16. Regarding claim 6, Marullo-Ramanathan further discloses the test instructions are further configured to direct the processor to record the browser activity as a series of steps and to edit the transaction to specify test measurements for each step [Marullo, col. 6, lines 24-49, col. 16, line 54 – col. 17, line 13 and col. 23, lines 5-24] [Ramanathan, col. 10, line 22 – col. 11, line 54].

17. Regarding claims 7-9, Marullo-Ramanathan further discloses one of the test measurements for each step is elapsed time, one of the test measurements for each step is a required string in an Internet server system response and one of the test measurements for each step is a prohibited string in an internet server system response [Marullo, col. 8, lines 27-40, col. 16, lines 54-65 and col. 30, line 58 – col. 31, line 9] [Ramanathan, col. 2, line 26 – col. 3, line 11 and col. 10, line 22 – col. 11, line 54].

18. Regarding claim 10, Marullo-Ramanathan further discloses the test instructions are further configured to direct the processor to record pauses for the steps and edit the transaction to redefine the pauses [Marullo, col. 23, line 14 – col. 24, line 24] [Ramanathan, col. 16, lines 51-64].

19. Regarding claims 12 and 16-20, claims 12 and 16-20 have similar limitations as claims 2 and 6-10. Therefore, the similar limitations are disclosed under Marullo-Ramanathan for the same reasons set forth in the rejection of claims 2 and 6-10 [Supra 2 and 6-10].

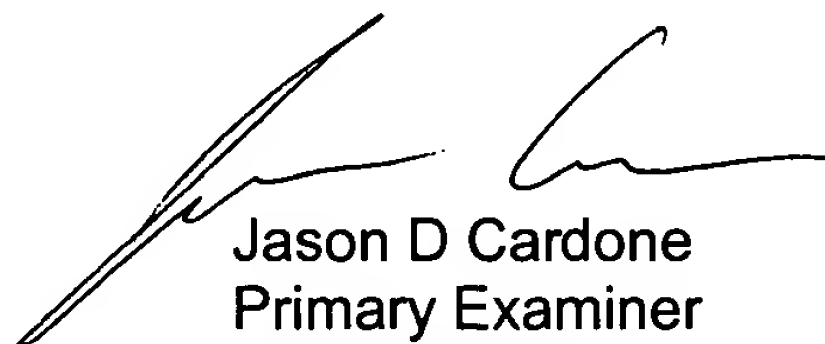
### ***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone  
Primary Examiner  
Art Unit 2145

February 6, 2005